

No. 10,000.

IN THE  
United States Circuit Court of Appeals  
FOR THE NINTH CIRCUIT

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RUDOLPH LENSCH and PAUL LEDER,

*Appellants,*

*vs.*

METALLIZING COMPANY OF AMERICA, a corporation, L. E.

KUNKLER, CHARLES BOYDEN and JOSEPH GOSSNER,

*Appellees.*

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APPELLANTS' REPLY BRIEF.

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FILED

APR 23 1942

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APPELLANTS' REPLY BRIEF.

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**Introduction.**

Appellees' (defendants') argument appears to be directed to the following general points which we have gleaned from a reading of the entire brief:

- (a) That mechanical skill only was involved in the claimed subject matter of the patent in suit;
- (b) That the patent in suit is a secondary patent;
- (c) That file wrapper estoppel prevents a construction of the claims broad enough to cover the defendants' gun.
- (d) That there was a constructive abandonment of the invention prior to filing the application.

We will discuss these in the order enumerated.

## 1. Invention Is Present.

Defendants say that the idea of forming the combustion unit of a gun as a separate and distinct entity from the mechanical unit or power plant of the gun was old in the French patent, Exhibit C [Tr. 442] and that the idea of providing in a spray gun a casting as an integral part which will contain the housing for encompassing the gears of the transmission as well as the turbine for driving the transmission gears, and to so form the casting that it will have a channel way for the feed wire, free and clear of the interiors of the gear and turbine housings was also old many years prior to the application—being most clearly shown, they assert, in the French patent, Exhibit C [Tr. 442] and in the French gun, Exhibit N, etc. (Appellees' brief, p. 3; further comments pp. 5-6, and 37-40.)

An important distinction to be drawn between these prior disclosures and the patent in suit is that in the latter (as well as in the Mogul gun) either unit will function independently of the other, and is separately replaceable, whereas in the prior guns mentioned the gas and air passages are formed in the casting of the gear housing and both units are integral.

Defendants further confuse an open space within a common casting as a channel. In the patented gun and in the Mogul the turbine housing and the gear housing are formed so that either one is fully enclosed by itself, that is by the walls surrounding each mechanism. The gears and shaft are on the side opposite the turbine, and the adjacent walls of each separate compartment or unit form the walls of the open channel.

Defendants *concede* (Brief page 5) that the following from our opening brief, page 5, *correctly describe features of novelty in plaintiffs' patent not found in the prior art*: "The location of knurled wheels which deliver the wire, in an open channel between the wall of the turbine housing and the adjacent wall of the transmission housing." Defendants further confirm this in their brief at page 23 where they say as follows: "The 'open channel' is formed between the housings in the body and the walls thereof, and in that true and actual sense, plaintiffs' gun is the only gun in all the prior art so constructed and arranged."

Defendants would apparently insist that this is nothing more than carrying forward old ideas in an effort to make a more efficient metal spray gun (Brief page 39).

Invention is at best a vague term evading measurement by a strict rule. The Lensch and Leder patented gun obviously involves a certain amount of mechanical skill in its design, but goes beyond that in the creation of a spray gun of higher capacity (more pounds of metal being sprayed in a given time) less maintenance cost, better balanced gun and increased general efficiency, facts which are emphasized by the testimony, in plaintiffs' literature, and confirmed in the advertising literature of the defendants. If Mr. Boyden was in the possession of all his foreign models and prior patent disclosures why did he not improve the *old metallizer gun* which followed that prior art, before he had seen plaintiffs' patented gun? He is an engineer of recognized skill, and were mechanical skill only involved in devising the patented gun he should have produced the Mogul long before he saw the Lensch and Leder patented gun.

He copied the essence of plaintiffs' invention. He probably used some mechanical skill in specifically designing the different parts and embodying them into his gun, but he did not design his gun without being guided almost wholly by the construction of plaintiffs' patent. That should be a sufficient answer to defendants' argument that only mechanical skill was involved.

*Bankers' Utilities Co., Inc. v. Pacific Nat. Bank*  
(C. C. A. 9), 18 Fed. (2d) 16, 18.

This Court has repeatedly recognized *invention* as being present in patents for relatively simple improvements which increase efficiency, notwithstanding the various elements of the combination may be found in the prior art.

*Los Alamitos Sugar Co., et al. v. Carrol* (C. C. A. 9), 173 Fed. 280;

*San Francisco Cornice Co. v. Beyrle* (C. C. A. 9),  
195 Fed. 516;

*H. J. Heinz Co. v. Cohn* (C. C. A. 9), 207 Fed.  
547.

Moreover, the wide commercial adoption of the patented gun is strongly persuasive of invention,

*Sherman-Clay v. Searchlight Horn Co.* (C. C. A. 9), 214 Fed. 86, 93,

and the infringer's commercial success also fortifies the presumption of validity of the patent which he infringes.

*Dillon Pulley Co. v. McEachran* (C. C. A. 6), 69  
F. (2d) 144, 146.



## 2. Patent Is Secondary but Nevertheless Infringed.

As to defendants' second point that the Lensch and Leder patent is secondary, we have affirmatively declared that from the outset. It is unquestionably an improvement patent, and its claims must be narrowly construed. That however does not rob the patent of its effect.

The courts will protect a patentee even in a crowded field, and even when his invention must be restricted essentially to the form shown and described by him, against a copy which seeks with some change in form and position to use the substance of the invention.

*Ives v. Hamilton*, 92 U. S. 426, 430, 23 L. Ed. 494;

*Sanitary Refrigerator Co. v. Winters* 280 U. S. 30, 42, 50 S. Ct. 9, 74 L. Ed. 147;

*Bankers' Utilities Co., Inc. v. Pacific Nat. Bank* (C. C. A. 9), 32 Fed. (2d) 105, 108;

*E. H. Bardes Range and Foundry Co. v. American Engineering Co.* (C. C. A. 6), 109 Fed. (2d) 696, 698.

## 3. File Wrapper Does Not Exclude Defendants' Construction.

In their third major proposition defendants discuss the Lensch and Leder file wrapper at length (Appellees' Brief, pp. 8-16), citing law to the effect that a patentee may not secure a construction of his claims covering the same broad territory described by claims rejected and cancelled.

With this rule of law we are in agreement.

We say, however, that the most careful review of the file wrapper does not support the conclusion reached by

defendants, namely that the Mogul gun lacks a construction embodying an open channel between the wall of the turbine housing and the adjacent wall of the transmission housing, with knurled wire feeding wheels located in said open channel.

For the purposes of this argument we may assume that the claims in suit must be restricted substantially to the form shown in the drawings and described in the specification. The Mogul obviously incorporates some change in form and position of parts. Thus the latch in the patent is pivoted in the front, and the latch in the Mogul is pivoted at the rear. The *degree* of visibility differs, *but is present in both*. The physical appearance in general differs in matters of mere design.

This all sums up to the proposition that Mr. Boynden, the designer of the Mogul gun employed his skill merely in giving the outlines of the Mogul gun a modified appearance from the outlines of the patented gun. He did incorporate the improved functional qualities of the patented gun, as he admitted. [Tr. pp. 111 and 112.] In making this change from his old metalizer, Mr. Boynden was required to lengthen the shaft transmitting power from the turbine to the gear housing sufficiently to reach the greater distance caused by placing the channel between the turbine and the gear housing, a feature of construction absolutely copied in the Mogul from the Lensch and Leder patented gun, a comparison of the two physical specimens showing that the shaft in both guns are almost identical in length.

The defendants' advertising literature acknowledged by Boyden [Plaintiffs' Exhibits 10-A, 10-B, 10-C and 10-D; Tr. 71 *et seq.*] is filled with laudatory statements identify-

ing the *construction* of the Mogul in a manner which brings it squarely parallel to the Lensch and Leder *disclosure*.

The whole "file wrapper argument" is disposed of by the simple query: Were the features of similarity between the patented gun and the defendants' gun found in any prior art? The answer is no. Therefore there is nothing to restrict the claims whereby the Mogul gun is excluded from their scope. **The wording of the claims introduced by amendment reads on the Mogul, and therefore in the absence of a construction similar to the Mogul somewhere in the file references, the claims are infringed.**

Inferiority of the defendants' Mogul gun in respect to the *degree of visibility*, and the *size or extent of the open channel* is inconsequential and does not avoid infringement.

*Smith Pottery Machine Co. v. Seattle-Astoria Iron Works, et al.* (C. C. A. 9), 261 Fed. 85;

*Bankers' Utilities Co., Inc. v. Pacific Nat. Bank* (C. C. A. 9), *supra*, 32 Fed. (2d) 105, 108.

#### **4. The Defense of Constructive Abandonment Is Not Before This Court.**

Under the heading of "DEFENSE OF PRIOR PUBLIC USE AND OFFER FOR SALE," beginning at page 23 of their brief, defendants state that "ONE of the defenses urged by defendants was that the invention of the patent in suit was made and offered for sale more than two years before the filing of the application for patent."

This defense was introduced for the first time by amendment to the answer made by leave of court at the

trial. [Tr. 17a, 150.] The amendment to the answer set forth in the transcript at page 17a and in appellee's (defendants') brief at page 24 is limited to certain particulars therein specified.

The proofs offered by defendants on this subject were discussed by the District Court in its opinion [Tr. pp. 22-25], holding that defendants' evidence on the point "falls far short of the required proof, to establish that the patent invention 'was known and used and circularized and offered for sale' more than two years prior to April 13, 1936, the date of the application therefor." [Tr. p. 24.]

The findings of fact and conclusions of law are wholly silent on this part of the opinion. Defendants presumably prepared the findings of fact and conclusions of law and form of "decree" [judgment] for they were directed to do so by the District Court [Tr. pp. 35-36]; and in any event made no objection to the omission from the findings of fact and conclusions of law and the judgment, of a reference to or finding or conclusion upon this alleged defense.

It is therefore to be inferred that defendants abandoned the defense after learning the District Court's views thereon as expressed in the opinion. In any event we think defendants are now barred from asserting such defense for the reasons stated.

Defendants cite the decision of this Court in *Oliver-Sherwood Co. et al v. Patterson-Ballagh Corp., et al.*,

95 Fed. (2d) 70, to the effect that where patents are held valid but not infringed and plaintiffs appeal and attack the finding of non-infringement, defendants, without a cross appeal, may attack that portion of the findings and decree which holds the patent valid. (Appellee's Brief, pages 25-26.) Incidentally the quotation contained in Appellees' Brief indicated to be the language of the court is merely a copy of a paragraph in the syllabus, but accepting such summary as a fair statement of this Court's holding, it is noted that the decision only permits attack without a cross appeal upon that **portion** of the *findings* and *decree* which holds the patent valid.

While we do not question this Court's right to here consider validity without a cross appeal in the light of prior art referred to in the findings, conclusions of law and judgment, there are no findings or conclusions upon the defense under discussion, and consequently appellees' citation is not authority for the point they urge.

In this connection it should be observed that the prior art patents are before this Court. No question as to their issuance and existence has been raised, whereas the alleged constructive abandonment was held in the District Court's opinion to have failed of proof. Thus any issue on that subject before this Court would not be whether the device alleged to have been made and offered for sale meets the claims of the patent in suit, but primarily whether the evidence is sufficient to establish the making and offering for sale.

As we did not argue the merits of this issue in our opening brief, and do not believe it is before this Court, we have reserved argument thereon for the Appendix, to which reference is requested only if the Court accepts the issue for consideration.

Respectfully,

HERBERT A. HUEBNER,  
*Attorney for Appellants.*

Los Angeles, Cal., April 22, 1942.



## APPENDIX.

Should this Court decline to follow us in refusing to consider the alleged defense of constructive abandonment, and without waiving our objection thereto, we submit the following discussion of this subject, which may be disregarded by this Court if the defense is not to be considered.

### **The Evidence of Defendants Falls Far Short of the Required Proof to Establish That the Patented Invention "Was Known and Used and Circularized and Offered for Sale" More Than Two Years Prior to the Application Therefor.**

The application was filed April 13, 1936, and the critical date therefore is April 13, 1934.

In considering this defense several elementary rules of law should be remembered. First, "circularized" is not the pleading of prior publication as required by the statute. A prior writing, drawing or the like must be *published* in order to become effective. Public knowledge, standing alone, works no constructive abandonment. (*Walker on Patents*, Deller's Edition, p. 356, Sec. 89.) Proof of the remaining allegation of "on sale" must show that the offer for sale was a commercial transaction. For instance, where the inventor is obliged to place the invention in the hands of others for crucial experiments he may sell specimens for the purpose and the statute will not apply. (*Walker, supra*, p. 353, *et seq.*)

Proof of prior use, sale, publication, etc., must be made beyond a reasonable doubt.

*Barbed Wire Patent Case*, 143 U. S. 275, 12 Sup. Ct. 443, 36 L. Ed. 154;

*Parker v. Stebler* (C. C. A. 9), 177 Fed. 210, 212-213;

*Paraffine Companies v. McEverlast, Inc.* (C. C. A. 9), 84 Fed. (2d) 335;

and other cases too numerous to mention.

A fatal defect about the defendants' proof was their failure to bring in any physical or documentary evidence of any probative value, and their failure to account for that deficiency. Defendants' two witnesses on this subject not only failed to corroborate each other but were lead into contradictions on both direct and cross-examination which proved their testimony entirely valueless.

WITNESS HARRY D. RICE:

This witness was associated in 1930 or 1931 for approximately eight months with the Metallizing Company of which Mr. Boyden at the time was chief engineer or shop superintendent. [Tr. p. 222.] The witness thereafter became, as he expressed it, connected with the Metal Spray Company as a partner of the plaintiffs herein. The witness volunteered that the spray gun which embodied the features of the patent in suit known as Model 126 was a superior mechanism to the type of gun Model 125 previously manufactured by the Metal Spray Company [Tr. pp. 233-236] and he then made futile attempts to fix the date when the first model 126 was ready to be photographed—whatever that may mean. In such con-



nection he stated [Tr. p. 236] “\* \* \* I would say, the early part of March or the middle or last of February. *I don't* know exactly.” (*Italics ours.*) On the same page, he could not even recall whether more than one gun was manufactured “about that time.” Almost in the next breath (same page) the witness contradicted himself by trying to fix the date not later than March 15th. He did not even state the year and it is only by recourse to the context of his testimony that the year 1934 can be inferred. The witness next attempted to identify a letter dated April 5, 1934, which purportedly was addressed to various distributors and agents but he could not remember the name of a single specific person to whom the letter was sent, if indeed any copies were placed in the mail. [Tr. pp. 237-238.] He immediately follows by saying that one of the letters was sent to Mr. Britton, although he had no independent recollection of that event and could only fix the same in his mind by referring to a long-hand note on the bottom of the letter in question. He did not testify as to when the letter was sent; and there is no presumption of law that a letter is sent on the day of its date. Moreover these were stock letters, and may have been held for weeks.

The witness then attempted to identify a “Bulletin 500.” He admitted [Tr. pp. 239-242] that it was not the one to which the letter referred.

The letter of April 5, 1934, was accepted in evidence, over the objections of counsel for plaintiffs, as Defendants' Exhibit “M.” The Court sustained an objection made by plaintiffs' counsel, that the original bulletin was not produced. The witness thereafter stated [Tr. p. 244] that “Bulletin 500” was prepared “from one of the first models of this type of gun produced.

Parenthetically, we will later show that there was only one specimen gun produced. It was used exclusively for experimental purposes. The first commercial or production gun was placed in the hands of the Shell Oil Company May 17, 1934. [Tr. p. 322.]

The witness Rice states that Bulletin No. 500 was copyrighted by him in 1934. He does not fix the month, and *the copyright registration receipt was not produced* and no explanation or excuse was made for that deficiency.

For the sake of continuity, we here inject some comments of defendants' attorney. Even he was not even prepared to fix any definite dates. This appears from his own statement [Tr. p. 246] as follows:

"\* \* \* in which correspondence the date is *more or less definitely fixed* as to when the gun was ready for shipment." (Italics ours.)

Still another statement of defendants' counsel is significant when he referred to a carbon copy of a purported letter of March 17, 1934, to De Laval Pacific Company (not in evidence), as

"\* \* \* just a scrap of evidence \* \* \* it may be that the original could be had but I know nothing about it." [Tr. pp. 253-5.]

The foregoing statement needs no comment.

Counsel immediately thereafter [Tr. p. 253] admitted that the carbon copy of the letter "is not the best evidence," and the Court remarked that the proof was insufficient except to show the letter as an "office record." [Tr. pp. 254-255.] There is nothing in the record to indicate the date on which the letter was placed in the mails, if indeed it was mailed, or who mailed it, and no attempt was made

to account for the original which was never produced. Receipt of the letter was never proved. Defendants' counsel thereafter abandoned his attempts to offer the letter in evidence. It was not proved, and is not in evidence, contrary to the statement in Appellees' Brief, page 28.

Again, the witness Rice contradicts himself by saying that the spray gun in question was "practically completed" in December, 1933, or January, 1934. [Tr. p. 271.] The witness thereafter stated that "one of the completed guns," [and we shall hereinafter show that only one gun was ever involved and not at the time witness specified] was shown by him to Mr. George Stoddard of the De Laval Pacific Company at San Francisco, on February 19, 1934. [Tr. p. 271.] It was only by "refreshing his memory" that the witness was able to set the date and the means for such memory refreshment were not disclosed. The details of that alleged disclosure were not given and the only comment made by the witness was stricken by the Court. [Tr. p. 272.] [Mr. Stoddard was not called as a witness, nor his deposition taken.]

To add to the general confusion attending this testimony, the witness further stated that the spray gun in question was

"\* \* \* used in the custom shop for tests for job work on a number of occasions in March, yes, sir."

and that it was used "after" that "on regular job work." [Tr. p. 275.] The first statement is that the gun was used for *tests* which implies experimental use and not public use. No details concerning such alleged use were given and the reasonable inference is that the use, if any,

was a private experimental use. The second portion of the witness' statement to the effect that the gun was used *after that* means nothing more than that it was used at some time. The statement could not be more indefinite as to time and certainly tends to establish nothing in the way of use or date of use.

Cross-examination of the witness Rice utterly destroyed any possible probative value of his testimony which may have been developed during direct examination. The witness could not remember whether the letter [Defendants' Exhibit "M"] had been folded, although it bore creases indicating folding at some time. [Tr. pp. 277-278.] The witness admitted that the letter had not been in his possession since it was allegedly mailed. He did not remember when it was mailed. He was not sure whether he had mailed it personally. [Tr. p. 278.] He was not "certain" who had printed the "Bulletin 500" which is a rather significant omission. [Tr. pp. 278-279.] He later stated that he was only reasonably sure that the printing had been done by the New Method Printing Company. In explanation of his deficient memory, the witness stated:

"We are looking back six years. \* \* \* I would not testify positively." [Tr. p. 279.]

He could not recall the name of the concern that had made the plates for the bulletin [Tr. p. 279], nor the price thereof. He had to speculate as to the number of bulletins printed. [Tr. p. 281.] He admitted having signed a Metal Spray Company check in payment for the printing

but did not remember the amount nor the date of the check. He admitted he had no records when he stated. [Tr. p. 281.]

“I can’t say. My records, you know *I don’t have them.*” (Italics ours.)

nor was any attempt made to account for their absence.

To add to that confusion [Tr. p. 281, *et seq.*] the witness stated that in paying for the bulletins he may have obtained sixty or ninety days’ credit or that he “might have” paid cash. He expressed doubt as to whether or not the New Method Printing Company did the printing. He produced a check in the sum of \$26.15, payable to the Carrol Photo Company of Los Angeles, said to cover the photographs which were reproduced in Bulletin No. 500. [The date of that check, it should be noted, is *June 28, 1934*, which is long after the critical date in question.] The witness thereafter reluctantly admitted that he had no way of identifying the particular copy of “Bulletin 500” which he had stated was mailed to Mr. Britton. He could not state the date when copies of Bulletin 500 were deposited in the copyright office, although he believed that such occurred within ten days after the printing order on April 10th or 15th, 1934. He could not remember when he executed the affidavit accompanying the application for copyright registration. He attempted to state what his usual custom was in securing copyrights and then admitted there were “some times exceptions. One gets careless sometimes.” [Tr. p. 288.]

Plaintiffs’ counsel then compelled the witness to produce a check drawn in favor of the New Method Printing Company, in the sum of \$30.00, dated *June 28, 1934*. The witness stated that it may have been for the printing of



“Bulletin 500.” “The records are incomplete.” [Tr. p. 289.]

Plaintiffs’ counsel then developed the fact that certain misunderstandings involving alleged embezzlement by the witness existed between him and the plaintiffs in this action. We invite the Court’s attention to those questions and answers at pages 289 *et seq.* of the record. We believe that the admissions wrung from the witness in that respect show prejudice against the plaintiffs and likewise bias in favor of the defendants by reason of his continuing employment with the Metallizing Company since June 15 of 1938 to the time of the trial. [Tr. p. 292.] The cross-examination on that point was finally terminated by the Court on the basis that the showing of bias had proceeded far enough. [Tr. p. 294.]

The witness whereafter admitted that he could not state whether an answer had been received to the letter, Defendants’ Exhibit “M”, and he failed to state that he or the defendants had made any efforts to establish whether or not an answer had been received or any other history relating to that matter.

As further indication of his unreliability, it should be noted that during his *direct* examination the witness attempted to disparage the merits of the patent in suit by stating generally that it does not involve patentable invention. Against that statement is his admission in a letter written by him to Mr. K. D. Falk during the period when he had an interest in the patent, in which he stated that a patent had been granted on the spray gun in question.

“\* \* \* which we believe protects our unique design against infringement to such an extent that we can adjudicate it fully in the courts, \* \* \*”  
[Tr. pp. 296-297.]

Witness William G. Britton:

Defendants made futile attempts to have Mr. Britton corroborate the preceding witness, Rice, although what he was supposed to corroborate was never clear. Britton refused to admit under direct examination that he had received the original letter dated April 5, 1934 [Defendants' Exhibit "M"], although he stated that he had received a similar letter. [Tr. p. 299.] When the witness' attention was directed to the longhand notation appearing on the letter he corrected himself to state that he had received the letter and a circular similar to "Bulletin 500." He could not state positively whether the circular shown him was the one which he had received with the letter. [Tr. p. 300.] He was unable to identify Mr. Rice's handwriting because it was

"\* \* \* several years ago and I don't remember his signature." [Tr. p. 301.]

The significance of Mr. Britton's testimony is his absolute refusal to fix any definite dates and particularly his statement [Tr. p. 302] that he received the letter in question

"in the Spring of 1934 as I remember,"

and likewise that he received one of the spray guns described in Bulletin 500 "in the Spring of 1934". He does not even amplify his statements which are indefinite as to time, with any explanation of what features the gun embodied (and his assertion that it was like one shown in the bulletin is merely a conclusion at best), or that he examined and understood the mechanism of the gun, which is essential, or what he did with the gun, or any of the particulars attending that alleged event.

Witness George Montgomery Hicks:

Another futile attempt was made by defendants to establish definite information regarding the alleged prior knowledge and use, "circularizing" or offer for sale. Hicks stated that he had mimeographed the Manual of Instructions for the Metal Spray Company [Defendants' Exhibit "P"] and that it was completed and delivered on April 7, 1934. The job was paid for by check [Defendants' Exhibit "Q"], dated April 6, 1934. [Tr. pp. 308 *et seq.*]

Under cross-examination, Mr. Hicks admitted he had no independent recollection of the job as it was

"pretty hard to remember six years back \* \* \*."  
[Tr. p. 311.]

Mr. Hicks' testimony has no effect whatsoever except possibly to show that the Manual of Instructions was mimeographed at some time. No connection between that fact and anything relevant in respect to alleged prior knowledge and use, circularizing or offer for sale was made, or even attempted.

Witness Ralph A. Brown (for plaintiffs in rebuttal):

Plaintiffs in rebuttal on the alleged special defenses produced Mr. Brown [Tr. pp. 313 *et seq.*], who is the proprietor of the New Method Printing Company referred to by defendants' witness Rice. He stated that the printing job for "Bulletin 500" was paid for by the Metal Spray Company, by check signed by Mr. Rice, dated June 28, 1934, and that the printing had been done no more than 30 days previous to that date. The amount involved was \$30.00. The check was accepted in evidence as Plaintiffs' Exhibit No. 16.



Witness Paul Leder (for plaintiffs):

Mr. Leder was recalled in rebuttal of the alleged special defenses and he established the very interesting and significant fact, and one which refutes a part of the Rice testimony, that only *one experimental spray gun* was produced. [Tr. p. 319.] *The gun at no time was permitted to leave the shop.* Rice had no key to the shop and he could not have had the gun in his possession, and at no time did Leder permit Rice to demonstrate or display the gun. [Tr. pp. 319 *et seq.*]

In that connection, and even assuming that the display of the gun to Mr. Stoddard in San Francisco was actually made at the time Rice said it had been, such display could amount to nothing more than a fraudulent, surreptitious and piratical use of the invention by Rice, and as such would not operate to show an abandonment of the invention by the plaintiffs. It was not, in any event, a "public" use which could even remotely constitute an abandonment of the invention by plaintiffs herein. That doctrine was discussed by the Circuit Court of Appeals of the Second Circuit in *Eastman v. Mayor, etc.*, 134 Fed. 844.

Mr. Leder goes on to state that the first commercial or production spray guns were completed and ready for delivery to customers about the first or the middle of May, 1934, and that time is *subsequent* to the critical date in question. [Tr. pp. 320-321.] Under cross-examination, Mr. Leder denied that Mr. Rice had ever used one of the plaintiffs' spray guns, and testified that

the alleged use was not within the scope of Rice's duties.  
[Tr. pp. 322 *et seq.*]

There is actually no conflict in the evidence when considered as a whole, including the testimony adduced by both plaintiffs and defendants, to indicate anything more than *experimental* or *test* use. No attempt was even made by defendants, as aforesaid, to show that any possible use thereof was a *public* use. The circumstances were never disclosed or discussed by defendants' witnesses and we are not warranted in speculating as to what might have happened but as to which no testimony was adduced. *The record is entirely bare of any credible testimony or evidence that the one metal spray gun was subjected to anything more than a private or experimental use more than two years prior to the filing of the application for the patent in suit.*

In summation of the defendants' feeble attempts to prove a prior public knowledge and use, circularizing and offer for sale, we are impressed with the rather obvious fact that defendants themselves had very little confidence in that defense. It should be remembered that defendants did not even specifically plead the defense and did not comply with the statute in giving plaintiff thirty days notice thereof prior to trial. It was upon that objection that the Court permitted an amendment to the complaint to incorporate the defense and adjourned court for one day in order to enable plaintiffs to make any necessary preparations to meet the additional defense. An exception was permitted plaintiffs and it is debatable whether or not the

Federal Rules of Civil Procedure abrogate or supersede the statute. The point is of relatively slight importance because of the inadequacy of defendants' attempted proofs on the subject. We take the position that there is not one scrap of evidence or of testimony in the record which is worthy of any credence or which has any real probative value. Conviction on that score would inevitably result when the clear law on the subject and the standard of evidence required are considered.

Respectfully,

HERBERT A. HUEBNER,  
*Attorney for Appellants.*

Los Angeles, Cal., April 22, 1942.

